



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,735	01/22/2002	Christopher Tzann-En Szeto	YHOOP002	2794

29989 7590 10/20/2006

HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

EXAMINER

MANIWANG, JOSEPH R

ART UNIT PAPER NUMBER

2144

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,735

Applicant(s)

SZETO ET AL.

Examiner

Joseph R. Maniwang

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 22-26 and 28-37 is/are rejected.
- 7) ☒ Claim(s) 20, 21 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Art Unit: 2144

DETAILED ACTION

1. In view of the Pre-Brief Conference request filed on 06/26/06, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Objections

2. Claims 10, 14, and 36 are objected to because of the following informalities:

3. Regarding claim 10, the claim does not end in a period.

4. Regarding claim 14, recitation of "claim1" is a typographical error.

Art Unit: 2144

5. Regarding claim 36, recitation of "comprises as plurality of servers" is a typographical error.
6. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 9, 18, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claim 9 recites the limitation "the inviting user". There is insufficient antecedent basis for this limitation in the claim.
10. Claim 18 recites the limitation "the IP address". There is insufficient antecedent basis for this limitation in the claim.
11. Claim 28 recites the limitation "the disable feature". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

Art Unit: 2144

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-19, 22-26, and 28-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhu (U.S. Pat. App. Pub. 2002/0194272).

14. Regarding claims 1, 34, and 37, Zhu disclosed a method and system comprising receiving an initial indication that the guest user desires to communicate with a selected registered user by instant messaging, wherein the initial indication specifically identifies the selected registered user with whom the guest user desires to communicate (see paragraphs [0039], [0040]); sending to a client computer system associated with the guest user browser-executable computer code comprising computer instructions for providing at least limited instant messaging functionality to the guest user at the client computer system, without requiring the guest user to download and install client side instant messaging application software and without requiring the guest user to registered as a user of the instant messaging system (see paragraph [0034]); and facilitating an instant messaging session between the guest user and the selected registered user (see paragraphs [0034], [0043]).

15. Regarding claim 2, Zhu disclosed the method and system wherein facilitating the instant messaging session comprises delivering instant messages from the guest user to the selected registered user (see paragraphs [0034], [0043]).

16. Regarding claim 3, Zhu disclosed the method and system further comprising providing an entry point configured to receive the initial indication

from the guest user that the guest user desires to communicate with the selected registered user by instant messaging (see paragraph [0035]).

17. Regarding claim 4, Zhu disclosed the method and system wherein the entry point is provided in an electronic mail message sent by the selected registered user to the guest user (see paragraphs [0034], [0040]).

18. Regarding claim 5, Zhu disclosed the method and system wherein the entry point is provided in a web page associated with the selected registered user (see paragraph [0035]).

19. Regarding claim 6, Zhu disclosed the method and system wherein the entry point is provided in an electronic document associated with the selected registered user (see paragraph [0035]).

20. Regarding claim 7, Zhu disclosed the method and system wherein the entry point is provided by computer code comprising code written in HTML (see paragraph [0047]; Fig. 5).

21. Regarding claim 8, Zhu disclosed the method and system further comprising receiving an indication from the selected registered user that the selected registered user would like to incorporate into an electronic mail message to the guest user an entry point configured to receive an indication from the guest user that the guest user desires to communicate with the selected registered user by instant messaging (see paragraph [0040]).

22. Regarding claim 9, Zhu disclosed the method and system further comprising receiving an indication from the selected registered user that the inviting user would like to incorporate into a web page associated with the

Art Unit: 2144

selected registered user an entry point configured to receive an indication from the guest user that the guest user desires to communicate with the inviting user by instant messaging (see paragraph [0040]).

23. Regarding claim 10, Zhu disclosed the method and system wherein the computer code comprises a browser-executable instant messaging client (see paragraph [0034]).

24. Regarding claim 11, Zhu disclosed the method and system wherein the browser-executable instant messaging client comprises computer instructions in DHTML (see Appendix A, p. 5).

25. Regarding claim 12, Zhu disclosed the method and system wherein the browser-executable instant messaging client comprises computer instructions in JavaScript (see Fig. 10).

26. Regarding claim 13, Zhu disclosed the method and system wherein to browser-executable instant messaging client comprises computer instructions in ActiveX (see Appendix B, p. 34).

27. Regarding claim 14, Zhu disclosed the method and system further comprising assigning a temporary user identification to the guest user (see paragraph [0045]).

28. Regarding claim 15, Zhu disclosed the method and system wherein the temporary user identification is unique to the guest user during the period during which it is assigned to the guest user (see paragraph [0045]).

29. Regarding claim 16, Zhu disclosed the method and system wherein the temporary user identification is at least temporarily deactivated upon termination

Art Unit: 2144

of the instant messaging session between the guest user and the selected registered user (see paragraph [0044]).

30. Regarding claim 17, Zhu disclosed the method and system wherein the temporary user identification is valid only for instant messaging with the selected registered user (see paragraph [0044]).

31. Regarding claim 18, Zhu disclosed the method and system wherein the number of temporary user identifications that may be assigned at any given time to the IP address associated with the client computer system is limited (see paragraph [0045]).

32. Regarding claim 19, Zhu disclosed the method and system further comprising prompting the guest user to provide a display name by which the guest user may be identified to the selected registered user (see paragraph [0036]).

33. Regarding claim 22, Zhu disclosed the method and system wherein the computer code is configured to display an instant messaging window to the guest user (see paragraph [0034]).

34. Regarding claim 23, Zhu disclosed the method and system wherein the instant messaging window comprises an area for displaying messages sent by either the guest user or the selected registered user (see paragraph [0034]).

35. Regarding claim 24, Zhu disclosed the method and system wherein the instant messaging window comprises an area for entering the text of a message to be sent and displayed to the selected registered user essentially in real time (see paragraph [0040]).

Art Unit: 2144

36. Regarding claim 25, Zhu disclosed the method and system further comprising advising the selected registered user that the guest user is not a registered user (see paragraph [0045]).
37. Regarding claim 26, Zhu disclosed the method and system wherein the selected registered user is associated with a registered user client computer system on which client side instant messaging application software associated with the instant messaging system is installed and the method further comprises disabling, at least with respect to the guest user, at least one feature of the client side instant messaging application software installed on said registered user client computer system (see paragraph [0040]).
38. Regarding claim 28, Zhu disclosed the method and system wherein the disabled feature is one that the computer code sent to the guest user's client computer system does not support.
39. Regarding claim 29, Zhu disclosed a method and system comprising receiving an initial indication that the invited user desires to communicate with the inviting user by instant messaging, wherein the initial indication specifically identifies the inviting user with whom the guest user desires to communicate (see paragraphs [0039], [0040]); sending to a client computer system associated with the invited user browser-executable computer code comprising computer instructions for determining whether the client side instant messaging application software associated with the instant messaging system is installed in the client computer system (see paragraph [0034]); and in the event it is determined that the client side instant messaging application software associated with the instant

Art Unit: 2144

messaging system is not installed in the client computer system, providing at least limited instant messaging functionality to the invited user at the client computer system, without requiring the invited user to download and install the client side instant messaging application software and without requiring the invited user to registered as a user of the instant messaging system (see paragraph [0034]); and facilitating an instant messaging session between the invited user and the inviting user (see paragraphs [0034], [0043]).

40. Regarding claim 30, Zhu disclosed the method and system further comprising in the event it is determined that the client side instant messaging application software associated with the instant messaging application software associated with the instant messaging system is installed in the client computer system, activating and using the installed client side instant messaging application software to enable the invited user to communicate with the inviting user by instant messaging (see paragraphs [0034], [0043]).

41. Regarding claim 31, Zhu disclosed the method and system wherein said computer instructions for determining whether the client side instant messaging application software associated with the instant messaging system is installed in the client computer system comprises computer code written in the JavaScript programming language (see Fig. 10).

42. Regarding claim 32, Zhu disclosed the method and system wherein said computer instructions for determining whether the client side instant messaging application software associated with the instant messaging system is installed in

Art Unit: 2144

the client computer system comprises computer code written in the VBScript programming language (see Appendix A).

43. Regarding claim 33, Zhu disclosed the method and system wherein said computer instructions for determining whether the client side instant messaging applicant software associated with the instant messaging system is installed in the client computer system comprises computer code written in the ActiveX programming language (see Appendix B, p. 34).

44. Regarding claim 35, Zhu disclosed the method and system wherein said web server comprises a plurality of servers (see paragraph [0035]).

45. Regarding claim 36, Zhu disclosed the method and system wherein said instant messaging server comprises as plurality of servers (see paragraph [0035]).

Allowable Subject Matter

46. Claims 20, 21, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

47. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection. Examiner submits that the claims are taught by the prior art of record as detailed in the rejections above under 35 U.S.C. 102(e).

Art Unit: 2144

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kim (U.S. Pat. No. 6,910,186)

D'Angelo (U.S. Pat. No. 6,717,938)

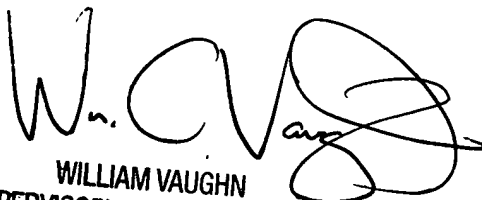
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2144

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM



WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100